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Anthony Edw. J. Campbell
PO Box 160370
Austin TX 78716-0370

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OFFICE OF PETITIONS

In re Application of :
Lesch Jr. et al. :
Application No. 10/603,235 : ON PETITION
Filed: June 24, 2003 :
Attorney Docket No. NWK1581 :

This is a decision on the renewed petition under 37 CFR 1.137(a), filed December 12, 2008, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. 704 for purposes of seeking judicial review. See MPEP 1002.02.

BACKGROUND

On June 28, 2005, the Office mailed a Corrected Notice of Allowance and Fee(s) Due and a Notice of Allowability (hereinafter "Notice of Allowance"),[1] which set a three-month statutory period for reply. The Notice of Allowance indicated that petitioner must pay a $700.00 issue fee by September 28, 2005, to avoid abandonment. In the absence of a timely filed reply, the application became abandoned on September 29, 2005. On May 26, 2006, the Office mailed a Notice of Abandonment, which was returned to the USPTO as undeliverable.

On November 6, 2006, petitioner filed a petition under 37 CFR 1.137(a), which was dismissed by the decision of May 21, 2007. On July 20, 2007, petitioner filed a renewed petition under 37 CFR 1.137(a), which was dismissed by the decision of July 24, 2007. On May 19, 2008, petitioner filed a second renewed petition under 37 CFR 1.137(a), which was dismissed by the decision of October 14, 2008. On December 12, 2008, petitioner filed the present petition in which petitioner reiterates his assertion that the delay was unavoidable due to non-receipt of the Notice of Allowance mailed on June 28, 2005.

[1] On October 19, 2004, the Office mailed a Notice of Allowance and a Notice of Allowability, which was returned as undeliverable. On January 12, 2005, the Office mailed a Notice of Allowability, which was returned as undeliverable. On June 28, 2005, the Office mailed the subject Corrected Notice of Allowance and Notice of Allowability, which was also returned to the USPTO as undeliverable.

STATUTES AND REGULATIONS

35 U.S.C. 133 states:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 151 states:

> If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.
>
> Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.
>
> Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.
>
> If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 CFR § 1.135 states:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
>
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR § 1.137 states:

> (a) Unavoidable. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under

§ 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

OPINION

37 CFR 1.137 provides for the revival of abandoned applications for failure to timely pay the issue fee for a utility application. A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to § 1.137(d).

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable". Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

DISCUSSION

On November 6, 2006, petitioner filed an initial petition under 37 CFR 1.137(a), asserting that the application was abandoned unavoidably due to non-receipt of the Notice of Allowance dated June 28, 2005. Petitioner stated that the practitioner relocated and updated his customer number to reflect his new address prior to the filing of this application. Petitioner indicated that the practitioner updated his address with the USPTO in 2003, and that the declaration on filing listed the customer number as the correspondence address. Petitioner argued that the return of the Notices of Allowance to the USPTO as undeliverable served as proof that the Notice of Allowance was not received.

On May 21, 2007, the Office mailed a decision dismissing the initial petition under 37 CFR 1.137(a). In the decision, the Office noted that the Notice of Allowance was returned to the USPTO with an indication on the envelope to "RETURN TO SENDER NOT DELIVERABLE AS ADDRESSES UNABLE TO FORWARD." The Office further noted that the declaration and transmittal letter submitted on filing included the Customer Number 30245, as well as the typed correspondence address of 6721 Northridge Drive, Dallas, Texas 75214-3156. The Office reminded petitioner that petitioner bore the burden of establishing that a timely change of correspondence address was submitted with the USPTO for this application. The Office informed petitioner that a review of the USPTO records revealed that a change of the correspondence address was entered by the USPTO on June 14, 2006, after the mail date of the Notice of Allowance, and that it appeared that the Notice was mailed to the address of record as it existed on June 28, 2005. The decision instructed petitioner that petitioner must provide documentary evidence with any renewed petition, such as (1) a copy of the "Request for Customer Number Data Change" (PTO /SB /124), requesting a change in the correspondence address associated with Customer No. 30245; (2) a copy of the "Change of Correspondence Address, Application " (PTO /SB /122), changing the correspondence address of this application to the address associated with Customer No. 30245; or (3) a copy of a request submitted electronically via a computer-readable diskette to change the correspondence address of this application to the address associated with Customer No. 30245, in order to demonstrate that petitioner changed the correspondence address associated with Customer No. 30245 to PO Box 160370, Austin TX 78716-0370, prior to the mailing of the Notice of Allowance on June 28, 2005.

On July 20, 2007, petitioner filed a renewed petition under 37 CFR 1.137(a), in which the practitioner stated:

> It is first noted that the original Utility Patent Application Transmittal sheet, filed *6/24/2003* via US Express Mail Label No. EU187567775US clearly indicated for the application correspondence address to be that associated with Customer Number 30245. The remaining question concerns when the address for that customer number was properly updated in 2003. Attorney shows by preponderance of the above evidence that the Customer Number address for 30245 was updated prior to the Notice of Allowance for the file at issue was mailed."

Petition dated 07/20/07, pp. 1- 2. However, neither petitioner nor the practitioner submitted any documentary evidence with the renewed petition, as requested in the decision of May 21, 2007, to support this assertion. Accordingly, the renewed petition was dismissed by the decision of January 17, 2008.

On May 19, 2008, petitioner filed a second renewed petition under 37 CFR 1.137(a), in which the practitioner argued: "Where an action is returned as undeliverable, the office must attempt to ascertain the correct address and re-mail the action, with the period being reset with the date of re-mailing." *Petition dated 05/19/08, p. 1.* In support of his argument, the practitioner cited to In re Gourtoff, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924). Specifically, the practitioner asserted:

> The Office neither selected the Customer Number address, which was updated in a timely manner, nor attempted to ascertain the correct address when it was returned as undeliverable. Attorney used due care to take all action necessary for proper response

> to outstanding Office actions, but could not respond to an Action that was unknown to Attorney because the Office did not follow its own procedures.

Petition dated 05/19/08, p. 1-2.

On October 14, 2008, the Office mailed a decision dismissing the second renewed petition. In the decision, the Office advised petitioner of the USPTO's procedures for remailing returned mail and confirmed that such procedures were followed in this application. Furthermore, the Office explained that the practitioner specified Customer Number 30245, as well as the typed correspondence address of 6721 Northridge Drive, Dallas, Texas 75214-3156 in both the declaration and transmittal letter submitted on the filing of this application. Therefore, in keeping with 37 CFR 1.33(a), the Office selected the address associated with the Customer Number over the typed correspondence address. However, the Office noted that address associated with Customer Number 30245 and the typed correspondence address (6721 Northridge Drive, Dallas, Texas 75214-3156) were the same at the time of the mailing and remailing of the Notices of Allowance. The decision informed petitioner that USPTO records showed that the practitioner did not submit a timely request with the Office to update the Customer Number address and associate the updated address with this application. Further, the Office noted that neither petitioner nor the practitioner submitted any documentary evidence with the second renewed petition, as requested by the USPTO, to support the assertion the Customer Number address for 30245 was updated prior to the date of mailing of the Notice of Allowance. The decision concluded that the USPTO correctly followed its procedures by entering the address associated with the Customer Number as the correspondence address of record over the typed address and correctly mailed the Notice of Allowance to the Customer Number address (6721 Northridge Drive, Dallas, Texas 75214-3156) as it existed on that date. Furthermore, the decision confirmed that the application became abandoned for failure to pay the issue fee timely and not due to any error by the USPTO in mailing the Notice of Allowance. The decision informed petitioner that if petitioner chose to file a petition for reconsideration, petitioner must include an exhaustive attempt to provide the lacking item(s) noted in the decision because the Director would not undertaken any further reconsideration or review of the matter after a decision on the petition for reconsideration. Once more, the decision directed petitioner to provide documentary evidence to demonstrate that petitioner changed the correspondence address associated with Customer No. 30245 to PO Box 160370, Austin TX 78716-0370, prior to the mailing of the Notice of Allowance on June 28, 2005.

On December 12, 2008, petitioner filed the present renewed petition in which petitioner reiterates his assertion that the delay was unavoidable due to non-receipt of the Notice of Allowance mailed on June 28, 2005. Petitioner continues to maintain that the practitioner updated the customer number in 2003 to reflect his new address. Specifically, petitioner states:

> The Office has noted that in both the declaration and the transmittal letter submitted on filing the application, practitioner specified Customer Number 30245. However, the Office is incorrect in its assertion that the Office properly selected the Customer Number at the time of filing. Rather, the Office improperly entered the practitioner's address at the time of filing despite both 37 CFR 1.33(a) and the clear indication, by check box, that the Customer Number be selected by OIPE. Unfortunately, such a selection contrary to both clear selection by a practitioner and 37 CFR 1.33(a) is not an uncommon experience. To wit, this practitioner has had to file several other petitions

> on the same basis. A review has spotted seventeen additional files that counsel filed that are not linked to counsel's customer number and are inaccessible to counsel via PAIR[.[2]]
>
> . . .
>
> Again, the Office has already noted that in both the declaration and the transmittal letter submitted on filing the application, the practitioner specified Customer Number 30245. The application was filed on June 24, 2003 using that number. Counsel for petitioner asserts that the Customer Number was not linked to the application at that time, but was linked to the file on June 14, 2006, when practitioner was encouraged to file yet another address update in order to ensure this application was linked to his Customer Number so practitioner could access the case in PAIR. This additional request date is being used against practitioner, as it is being asserted by the Office as the date which the Customer Number was updated, rather than the date on which a Customer Number, rather than a correspondence address, was used for the application. Practitioner asserts that (1) it was requested that the Customer Number be linked to the application at the time of filing, namely June 24, 2003; and (2) the practitioner address associated with the Customer Number was updated around the date of July 7, 2003. Alternatively, it could also be the case that another problem caused this particular case, as well as the other cases enumerated above, not to be updated in a timely manner when originally requested by the practitioner.
>
> . . .
>
> Unfortunately, because of a crashed hard drive and other computer updates, counsel for petitioner is not able to provide a copy of the address change request; however, counsel requests that the Office not dismiss petitioner for lack of this particular form, but rather consider other correspondence mailed by the Office to the counsel for petitioner prior to the date of the Notice of Allowance for this application. Counsel for petitioner provides documentary evidence that the date of the address update was approximately July 7, 2003 by referencing the following Notices of Allowance which are readily available to the Office, and prays and pleads that the Office examine and consider its own records on this issue. If the Office would prefer that the practitioner provide his own copies of these Notices of Allowance, counsel for petitioner will happily oblige.

Petition dated 12/12/08, pp. 2-4.

As documentary proof of the timely change of the correspondence address, petitioner identified 10 applications in which the Notices of Allowances were mailed after July 7, 2003, to the practitioner's updated Customer Number address of PO Box 160370, Austin TX 78716.

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[2] Petitioner submitted a table listing application that applicant asserts have not been associated with practitioner's Customer Number 30245, despite providing the Customer Number at the time of filing.

The Office has considered applicant's arguments; however, the Office does not find them persuasive. The Office reminds petitioner that the burden is on petitioner to show that the delay in responding to the Notice of Allowance was unavoidable within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a). The Office notes that a belated notification to the USPTO of a change of correspondence address does not constitute proper notification as to establish unavoidable delay. An applicant is responsible for promptly informing the Office of any change of address. Where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of "unavoidable" delay requires a showing that petitioner exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application at hand. MPEP 711.03(c)(III)(C)(2). Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987); Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Despite repeated opportunities, petitioner has not provided sufficient documentary evidence to support a finding of unavoidable delay. Petitioner continues to argue that he submitted a request to change the correspondence address associated with Customer No. 30245 to PO Box 160370, Austin TX 78716-0370 for a number of applications, including the instant application on July 7, 2003. However, petitioner has not provided the Office with either a computer-readable diskette or a list of applications for which the address change was requested. Moreover, petitioner has not shown that the present application was one of the applications for which petitioner submitted a request to update the address associated with Customer No. 30245 prior to the mailing of the Notice of Allowance on June 28, 2005.

After performing a thorough search of the USPTO records, as well as consulting with the Electronic Business Center and the System and Information Resources Administration, the evidence supports a conclusion that the practitioner did not submit a timely request with the Office to update the Customer Number address and associate the updated address with the present application. It is unfortunate that counsel for petitioner is unable to provide a copy of the address change request because of a crashed hard drive and other computer updates. However, in the absence of such documentary evidence, petitioner has failed to meet his burden of establishing that the delay was unavoidable. Accordingly, the Office cannot grant the present renewed petition. See Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Moreover, petitioner is not entitled to a refund of the petition fee. The Office notes:

> 35 U.S.C. 41(a)(7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

> In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

MPEP 711.03(c)(III)(B).

CONCLUSION

After a thorough review of all of the facts, the Office concludes that petitioner did not submit a timely request to change the address associated with the Customer Number to PO Box 160370, Austin, TX 78716-0370 or designate a new address associated with the Customer Number as the correspondence address in this application prior to the mailing of the Notice of Allowance. Accordingly, petitioner failed to demonstrate that the delay in paying the issue fee was unavoidable. The Director will not undertake any further review or reconsideration on the petition under 37 CFR 1.137(a).

The Office notes that if petitioner's delay in paying the issue fee was unintentional, a petition may be filed pursuant 37 CFR 1.137(b) to revive this abandoned application. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in 37 CFR 1.17(m); and,

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to 37 CFR 1.137 (d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By fax: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

Telephone inquiries should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Charles A. Pearson
Director
Office of Petitions